

REMARKS

Applicants request reconsideration of the application in view of the present Amendment.

Claim 6 is amended as suggested by the Examiner to overcome the objection, and further to add clarifying punctuation. Applicants respectfully submit that these are merely editorial amendments that do not change the scope of the claim, and respectfully request allowance of claims 6-8 as indicated in the Office Action.

New claims 9-13 are added to define the invention more broadly in view of the Examiner's statement of reasons for allowance of claims 6-8. Specifically, new claim 9 is similar to claim 6, but recites only those limitations that the Examiner identifies as not anticipated or made obvious by the prior art. Each of new claims 10-13 recites additional limitations that further distinguish the invention patentably from the prior art.

New claims 14-16 also are added to define the invention more broadly in distinction from the prior art. Like the preceding claims, claim 14 defines a thumbwheel input device "in an inclined orientation." The device includes a wheel that is rotatable about a first axis, and a holder supporting the wheel. As recited in claim 14, the holder supports the wheel in a rest position in which the wheel protrudes from the device housing "in the inclined orientation." The holder further supports the wheel for movement pivotally about a second axis from the rest position to an actuated position in which the switch responds to pivotal movement of the wheel.

In the published patent application of McLoone et al., the wheel 40 does not have a rest position in which it protrudes from the housing in an inclined orientation. Instead, the rest position of the wheel 40 is aligned with horizontal and vertical axes, without any inclination, because the rest position of the wheel 40 is the frame of reference from which the user pivots the wheel to begin horizontal or vertical scrolling of the image on the screen. An inclined frame of

reference for scrolling, rather than a level frame of reference, would require the user to compensate for the difference between an inclined rest position of the wheel 40 and the original position taken by the image before scrolling begins. This would be difficult, if not entirely unworkable. Accordingly, there is no suggestion or motivation for a person of ordinary skill in the art to modify the apparatus of McLoone et al. by providing the wheel 40 with an inclined rest position. Instead, an inclined thumbwheel rest position, as recited in claim 14, is incompatible with the disclosure of McLoone et al. under 35 USC § 103. It follows that pivotal movement of an inclined wheel from a rest position to an actuated position, as further recited in claim 14, could not have been made obvious by any interpretation of the prior art that relies on the disclosure of McLoone et al.

As defined in new claim 15, the holder supports the wheel for movement pivotally about the second axis from a first angle of inclination in the rest position to a second, lesser angle of inclination in the actuated position. In the apparatus of McLoone et al., the user first imparts an inclined orientation to the wheel 40 by pivoting the wheel 40 out of the level rest position. The angle of inclination then increases as the wheel 40 pivots further toward the actuated position. The apparatus of McLoone et al. thus functions oppositely to the claimed apparatus in which the angle of inclination decreases as the wheel pivots from the rest position to the actuated position. Since the amount of scrolling accomplished by the wheel 40 of McLoone et al. is directly related to the amount of inclination input by the user, Applicant's oppositely acting wheel could not have been made obvious under 35 USC §103 by the disclosure of McLoone et al.

New claim 16 defines the switch as a tactile switch supported on the holder for movement with the wheel pivotally about the second axis. As noted in the Office Action, this feature of the claimed invention is not anticipated or made obvious by the prior art.

In view of the foregoing remarks, Applicants respectfully submit that each of claims 6-16 is allowable, and allowance is requested.

Respectfully submitted,



Stephen D. Scanlon
Registration No. 32,755
(Attorneys for Applicant)
JONES DAY
901 Lakeside Avenue
Cleveland, Ohio 44114
216/586-7023